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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,720	11/30/2001	Andrew M. Spencer	10014185-1	4492

7590 04/25/2003

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
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EXAMINER

CHACE, CHRISTIAN

ART UNIT	PAPER NUMBER
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2187

DATE MAILED: 04/25/2003

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/996,720	Applicant(s) SPENCER ET AL.	
	Examiner Christian P. Chace	Art Unit 2187	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2187

DETAILED ACTION

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "Memory tally" is not described in the specification – it is merely recited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 4, 11, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, "Information about usage" is not elaborated upon to the extent required by 35 USC 112, second paragraph. For example, usage of what? The card itself, the memory in the card, or the entire system?

Claim 2 recites the limitation "the monitoring step" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "said event descriptor." There is no antecedent basis for this limitation in the claim. Applicant may overcome this rejection by possibly changing the dependency of claim 4 from claim 1 to be dependent upon claim 3.

The term "substantially" in claim 11 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

With respect to claim 14, if a readable storage *contains* AN event descriptor, meaning ONLY one, how, then, can EACH descriptor be claimed in the language immediately following the singular form. In other words, "EACH event" lacks antecedent basis because only one event is claimed thereby giving ONE event antecedent basis – not more than one, as is claimed by using the word "each."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimizu et al (US Patent Application Publication #2002/0107832).

With respect to claims 1 and 16, a method and system for storing memory card usage information on a memory card, comprising collecting information about the usage, recording the usage information in an area of the memory card, and accessing the information about usage is disclosed in paragraph 15. "Usage information" may be the number of times a website is accessed or the advertising usage disclosed therein.

With respect to claim 2, there is no monitoring step claimed in the claim upon which the instant claim depends. However, figure 4 discloses monitoring content reproduced (write events), websites (read events) and power-on events, which are inherent in that if the card records each transaction as discussed in paragraph 2 of Shimizu et al, then the card must be powered on for each of those transactions, and by keeping count of the transactions, power-on events are also inherently "monitored."

With respect to claim 3, the collecting step comprising changing a count associated with an event descriptor when the event occurs is disclosed in figure 9, #S1205.

With respect to claim 4, the collecting step comprising storing a "value parameter" associated with [an] event descriptor is disclosed in figure 4 as the "number of times."

With respect to claim 5, the collecting step comprising changing a "memory tally" associated with said event descriptor when the event occurs is disclosed in figure 6 as the number of times reproduction is possible.

With respect to claim 6, recording the information about usage in a dedicated area in said memory card is disclosed in figure 4.

With respect to claim 7, recording the information about usage in a "non-user accessible area" of memory is disclosed in figure 4, and further discussed in paragraph 61 as requiring input by a clerk. As applicants have not discussed which memory the "information about usage" might be stored in, examiner interprets the memory accessible by the clerk, a "non-user," as that memory. Alternatively, it could be interpreted as the clerk's memory itself. Either interpretation is anticipated by applicants' claim language as it stands instantly.

With respect to claim 8, changing a count associated with an event description when the event occurs, and wherein the accessing step comprises displaying the count is disclosed in figure 4, and the "displaying" is discussed in paragraph 59.

With respect to claim 9, a plurality of event descriptors, wherein said accessing step comprises displaying a plurality of the event descriptors (not all of them), wherein each of the displayed plurality of event[s] descriptors is "selectable," so that [up]on "selection," additional usage information will be displayed that is associated with the selected event descriptor is disclosed in paragraphs 59 through 61.

With respect to claim 10, the "displaying" step being performed at a "host" is disclosed in paragraph 61, as, "by a clerk."

With respect to claim 11, displaying real-time information about usage in a window on a screen at a host is disclosed in paragraph 61 as well.

With respect to claim 12, creating "write and read commands" allowing the host to store the information about usage and read that information is disclosed in paragraph 61.

With respect to claim 13, changing a count associated with an event descriptor when the event occurs, and further comprising the steps of comparing the count to a threshold, and if the threshold is equaled or exceeded, then causing a message to be sent is disclosed in paragraph 13, with the "message to be sent" being the targeted advertising.

With respect to claim 14, computer readable storage containing an event descriptor, and for [that] event descriptor (how can there be more than one if the storage CONTAINS AN event descriptor?) a count representing the number of occurrences of that event is disclosed in figure 4.

With respect to claim 15, an amount of memory used for [a] descriptor (see supra) is inherent – if data of any kind is to be saved, there must be a place to save it.

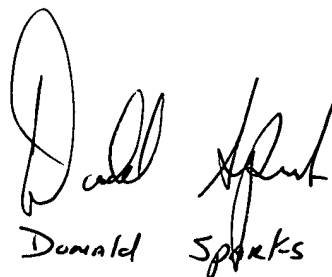
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian P. Chace whose telephone number is 703.306.5903. The examiner can normally be reached on 9-4-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Do Yoo can be reached on 703.308.4908. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.3719 for regular communications and 703.305.3719 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

Christian P. Chace
DS/cpc
April 21, 2003



Donald Sparks
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